DOCKET NO.: 246980US0DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Wilfried HEIDE, et al.

GROUP: 1713

SERIAL NO: 10/765,152

EXAMINER: EGWIM, KELECHI C.

FILED: January 28, 2004

FOR: CONTINUOUS PRODUCTION OF CROSSLINKED FINE PARTICLES OF POLYMER GEL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Stefan U. Koschmieder, Ph.D.
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IN RE APPLICATION OF	:
WILFRIED HEIDE, ET AL.	: EXAMINER: EGWIM, KELECHI C.
SERIAL NO: 10/765,152	:
FILED: JANUARY 28, 2004	: GROUP ART UNIT: 1713
FOR: CONTINUOUS PRODUCTION OF CROSSLINKED FINE PARTICLES OF POLYMER GEL	:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Further to the final Office Action of September 11, 2006, Applicants request pre-appeal review of the rejections of the above-identified application.

Remarks begin on page 2 of this paper.

REMARKS

Applicants submit that the rejection of the presently pending claims as anticipated under the meaning 35 U.S.C. § 102(e) and/or obvious under the meaning 35 U.S.C. § 103(a) in view of a patent to Tsubakimoto (U.S. 4,625,001) contains clear legal and/or factual errors meriting withdrawal of the rejection.

Independent Claim 10 is drawn to a process that includes copolymerizing a monomer mixture. The following is expressly recited in the independent claim (underlining added):

> ... copolymerizing a monomer mixture...
>
> ... wherein... the copolymerizing is carried out in the presence of initiator at from 0 to 140°C by continuously feeding the aqueous solution of the monomers into a mixing kneader having at least two axially parallel rotating shafts having a plurality of kneading and transporting elements to convey the monomer mixture from an upstream end of the mixing kneader in the axial direction toward a downstream end of the mixing kneader by the continuous conveying action of the transporting elements of the rotating shafts.

The Office is of the opinion that Tsubakimoto describes a device and/or process the meets the above-quoted portion of present independent Claim 10. In support of the rejections, the Office points to Figures 4 and 5 of Tsubakimoto as proof that the prior art describes the presently claimed process. In particular, the Office asserts that reference numerals 26 and 29 of Figures 4 and 5 of Tsubakimoto represent parallel rotating shafts that convey a monomer mixture from an upstream location to a downstream location (see paragraph no. 8 on page 3 of the September 11, 2006 Office Action).

First, contrary to the present claim limitations, the shafts identified as reference numeral 26 in Figures 4 and 5 of Tsubakimoto do not have transporting elements. The shafts identified by reference numeral 26 are described as follows at column 5, lines 32-36 of Tsubakimoto (underlining added):

> The vessel was provided near the bottom portion thereof with a plurality of mutually parallel rotary stirring shafts 26 using

> Banbury type stirring blades as shown in FIG. 5 and further with a discharge screw 29.

Thus, Tsubakimoto does not disclose a mixing kneader having at least two axially parallel rotating shafts having a plurality of kneading and transporting elements such as that required by the present claims.

Second, it appears that the Office is taking official notice that the stirring shafts identified as reference numeral 26 in Figures 4 and 5 of Tsubakimoto function to convey a mixture from an upstream end to a downstream end of a mixing kneader. Applicants submit that such an interpretation makes no sense and is directly contradictory to the Tsubakimoto disclosure. Tsubakimoto identifies the shafts having reference numeral 26 as stirring shafts. If stirring shafts had a conveying function, all of the mixture present in a mixing apparatus would end up at one end of the container. Obviously this makes no sense because such mixing would be inefficient.

Applicant submit that, at best, Tsubakimoto discloses only a single rotating shaft having transporting elements in Figures 4 and 5; namely, reference numeral 29 which is identified as a "discharge screw" at column 5, line 36 of Tsubakimoto.

Applicants submit that the Office's rejection of the present claims as anticipated in view of Tsubakimoto is legally incorrect because Tsubakimoto does not disclose at least one of the present claim limitations; namely, the use of "at least two axially parallel rotating shafts having transporting elements to convey a monomer mixture from an upstream end of the mixing kneader in the axial direction toward a downstream end of the mixing kneader by the continuous conveying action of the transporting elements of the rotating shafts." Because Tsubakimoto does not disclose all of the features of the present claim, Tsubakimoto cannot anticipate the presently claimed invention.

Applicants further submit that the Office's assertion (e.g., the Office's official notice) that the stirring shafts identified as reference numeral 26 in Figures 4 and 5 of Tsubakimoto

have transporting elements or otherwise convey mixtures from an upstream end to a downstream end of a mixing kneader, is factually incorrect and is in direct contradiction to Tsubakimoto's description, e.g., see column 5, lines 32-36 of Tsubakimoto.

The difference between the stirring shafts of Tsubakimoto and the shafts recited in the presently claimed invention was discussed in the Amendment filed on June 8, 2006 in the present application (see page 10, line 20 through page 11, line 20 and the technical information, U.S. Patent No. 5,407,266, submitted with the June 8 Amendment).

Applicants submit that the outstanding rejections in the present application are not supportable and should be withdrawn, and the application allowed for the reasons discussed above; including, (i) the Office's clear legal errors, i.e., the rejection of the present claims as anticipated in view of prior art that does not disclose all of the present claim limitations, and (ii) the Office's clear factual errors, i.e., the Office's mischaracterization of the stirring shafts of Figures 4 and 5 of Tsubakimoto as functioning to transport and/or convey material in an upstream to downstream direction.

Respectfully submitted,

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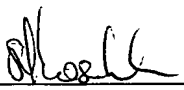

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